Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 December 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.   A rejection based on double patenting of the "same invention" type finds its
support in the language of 35 U.S.C. 101 which states that "whoever invents or
discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis
added). Thus, the term "same invention," in this context, means an invention drawn to
identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re
Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970).

        A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in
scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection
based upon 35 U.S.C. 101.

2.   Claims 1-39 are rejected under 35 U.S.C. 101 as claiming the same invention as

that of claims 1-39 of prior U.S. Patent No. 6,674,911. This is a double patenting

rejection.

        For example comparing representative claim 1 of the present application with

representative claim 1 of issued U.S. Patent No. 6,674,911: Claim 1 of the present

application recites: A method for one of encoding and decoding a N-dimensional data

set, comprising: (Claim 1 of issued U.S. Patent No. 6,674,911 recites: A method for one

of encoding and decoding a N-dimensional data set, comprising:); Claim 1 of the

present application continues to recite: (a) subband decomposing the N-dimensional

data set to thereby generate a N-dimensional subband decomposition; (Claim 1 of

issued U.S. Patent No. 6,674,911 continues to recite: (a) subband decomposing the N-

dimensional data set to thereby generate a N-dimensional subband decomposition;);

Claim 1 of the present application continues to recite: (b) initializing a list of insignificant

set of points (LIS), a list of significant points (LSP), and a list of individual insignificant

points (LIP); (Claim 1 of issued U.S. Patent No. 6,674,911 continues to recite: (b)

initializing a list of insignificant set of points (LIS), a list of significant points (LSP), and a

list of individual insignificant points (LIP);); Claim 1 of the present application continues

to recite: (c) populating the LIS with sets, each of the sets being designated by a root

node within the N-dimensional subband decomposition and having a corresponding tree

structure of points within the N-dimensional subband decomposition, which tree

structure of points is organized as descendants and offspring of the root node but not

including the root node; (Claim 1 of issued U.S. Patent No. 6,674,911 continues to

recite: (c) populating the LIS with sets, each of the sets being designated by a root node

within the N-dimensional subband decomposition and having a corresponding tree

structure of points within the N-dimensional subband decomposition, which tree

structure of points is organized as descendants and offspring of the root node but not

including the root node;); Claim 1 of the present application continues to recite: (d)

populating the LIP with points from within the highest designated subband of the N-

dimensional subband decomposition; (Claim 1 of issued U.S. Patent No. 6,674,911

continues to recite: (d) populating the LIP with points from within the highest designated

subband of the N-dimensional subband decomposition;); Claim 1 of the present

application continues to recite: (e) evaluating the descendants of the root node of each

of the sets for significance (Claim 1 of issued U.S. Patent No. 6,674,911 continues to

recite: (e) evaluating the descendants of the root node of each of the sets for

significance); Claim 1 of the present application continues to recite: (f) for each root

node of a respective one of the sets having at least one significant descendant,

evaluating descendants of the offspring of the root node for significance; (Claim 1 of

issued U.S. Patent No. 6,674,911 continues to recite: (f) for each root node of a

respective one of the sets having at least one significant descendant, evaluating descendants of the offspring of the root node for significance;); Claim 1 of the present application continues to recite: and (g) if the root node has at least one significant descendant of offspring, then adding additional sets corresponding to each of the offspring of the root node to the LIS as a root node thereof; (Claim 1 of issued U.S. Patent No. 6,674,911 continues to recite: and (g) if the root node has at least one significant descendant of offspring, then adding additional sets corresponding to each of the offspring of the root node to the LIS as a root node thereof;); Claim 1 of the present application continues to recite: and (h) moving one of the points from the LIP to the LSP when a coefficient associated with a point is greater than or equal to the predetermined threshold; (Claim 1 of issued U.S. Patent No. 6,674,911 continues to recite: and (h) moving one of the points from the LIP to the LSP when a coefficient associated with a point is greater than or equal to the predetermined threshold;); Claim 1 of the present application continues to recite: wherein: N is a positive integer; the LSP initially comprises an empty set; a first generation of the descendants comprise the offspring, (Claim 1 of issued U.S. Patent No. 6,674,911 continues to recite: wherein: N is a positive integer; the LSP initially comprises an empty set; a first generation of the descendants comprise the offspring,); Claim 1 of the present application continues to recite: a significant descendent of the descendants of the root node has a coefficient greater than or equal to a predetermined threshold; and (Claim 1 of issued U.S. Patent No. 6,674,911 continues to recite: a significant descendent of the descendants of the root node has a coefficient greater than or equal to a predetermined threshold; and);

Claim 1 of the present application finally recites: a significant descendant of the

offspring of the root node has a coefficient greater than or equal to the predetermined

threshold. (Claim 1 of issued U.S. Patent No. 6,674,911 finally recites: a significant

descendant of the offspring of the root node has a coefficient greater than or equal to

the predetermined threshold.).

As the comparison shows claim 1 of the present application is the same claim

word-for-word as claim of the U.S. Patent No. 6,674,911.

Claims 2-39 of the present application are word-for-word the same claims 2-39 of

prior U.S. Patent No. 6,674,911.

3.   The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure.

Kovacevic, Zhang et al., Shapiro, and Vishwanath et al. all discloses systems

similar to applicant's claimed invention.

4.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Jose L. Couso whose telephone number is (703) 305-
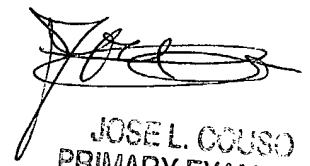4774. The examiner can normally be reached on Monday through Friday from 6:30 to
3:00.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number
for the organization where this application or proceeding is assigned is (703) 872-9306.
        Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (703) 305-
8576.
        Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Jlc
October 15, 2004

JOSE L. COUSO
PRIMARY EXAMINER